

1 Brent N. Bumgardner (Pro Hac Vice)
Christie B. Lindsey (Pro Hac Vice)
2 Jonathan H. Rastegar (Pro Hac Vice)
Nelson Bumgardner Casto, P.C.
3 3131 West 7th Street, Suite 300
Fort Worth, Texas 76107
4 Telephone: 817.377.3488
Facsimile: 817.377.3485
5 bbumgardner@nbclaw.net
clindsey@nbclaw.net
6 jrastegar@nbclaw.net

7 Robert W. Hicks (Cal. Bar No. 168049)
Kenneth R. Wright (Cal. Bar No. 176325)
8 Robert W. Hicks & Associates
14435 Big Basin Way, Suite 151
9 Saratoga, CA 95070
Telephone: (619) 846-4333
10 Facsimile: (408) 624-9369
rhicks@rwhlaw.com
11 kwright@rwhlaw.com

12 Attorneys for Plaintiff and Counter-Defendant
JONGERIUS PANORAMIC TECHNOLOGIES, LLC.

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 OAKLAND DIVISION

16 JONGERIUS PANORAMIC
17 TECHNOLOGIES, LLC,

18 Plaintiff,

19 vs.

20 GOOGLE INC., et al.,

21 Defendants.

) Case No.: C 12-03797 YGR
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) **STIPULATION TO STAY LITIGATION**
) **PENDING THE OUTCOME OF INTER**
) **PARTES REVIEW**

) **JURY TRIAL DEMANDED**
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**STIPULATION TO STAY LITIGATION PENDING
THE OUTCOME OF INTER PARTES REVIEW**

This stipulation is made among Plaintiff Jongerius Panoramic Technologies LLC (“JPT”), Defendant Google Inc. (“Google”), and Defendant Apple Inc. (“Apple”) (collectively, the “Parties”), by and through their respective counsel. Pursuant to Civil Local Rule 6-2 and 7-12, the Parties herein agree and stipulate as follows:

1. **Background.** This case is in its early stages. Indeed, discovery has just begun, no claim construction briefs have been filed, and no depositions have taken place. Damages discovery is stayed pending further order of the Court. Docket No. 125.

2. On March 15, 2013, Apple and Google jointly petitioned the U.S. Patent and Trademark Office (“PTO”) to conduct an *inter partes* review (“IPR”) of the sole patent-in-suit, U.S. Patent No. 6,563,529 (“the ’529 patent”). A copy of the petition is attached hereto as Exhibit A.

3. On April 5, 2013, the Court entered the Case Management Order. Docket No. 153. Additionally, the Court set a Technology Tutorial for July 10, 2013 and a Claim Construction Hearing for July 17, 2013. *Id.* The Court has not set a trial date.

4. The Parties now seek to stay all deadlines in this case pending the outcome of the IPR. In support of a stay, the Parties represent as follows: (1) by statute, the IPR takes a maximum of eighteen (18) months; (2) the IPR will either eliminate the need for trial or simplify the issues before the Court (e.g., validity issues); (3) staying the lawsuit pending the outcome of the IPR will promote judicial economy by eliminating the possibility of duplicative proceedings during the litigation (e.g., two Claim Construction Hearings); (4) staying the lawsuit pending outcome of the IPR will eliminate the possibility of duplicative discovery (e.g., multiple depositions of party and third party witnesses); and (5) all Parties are in favor of staying the litigation pending conclusion of the IPR.

5. **Legal Standard.** Courts consider three factors in determining whether to stay a case pending a reexamination of the patent-in-suit: “(1) whether discovery is complete and whether a trial date has been set; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party.” *Telemac Corp. v. Teledigital, Inc.*, 450 F. Supp. 2d 1107, 1111 (N.D. Cal. 2006) (citation omitted). The Parties agree that the circumstances warrant staying the litigation pending conclusion of the IPR.

6. With respect to the first factor, this case is in its early stages. The Parties represent that: (1) discovery has just begun and no depositions have been taken, (2) no claim construction briefs have been filed, (3) damages discovery has been stayed, and (4) no trial date has been set.

7. With respect to the second factor, the stay will simplify the issues before the Court. The IPR is an administrative proceeding conducted by the PTO for the purposes of determining the validity and scope of an existing patent. *See* 35 U.S.C. §§ 301-319, *et seq.* Once a petition is filed, the PTO is statutorily required to decide whether to institute a review within three months of the PTO receiving a preliminary response by the patent owner or if no such preliminary response is filed, the last date on which such response may be filed. 35 U.S.C. § 314(b). If the proceeding is instituted and not dismissed, a final determination by the Board will be issued within one year (extendable for good cause by six months). 35 U.S.C. § 316(a)(11). Thus, the entire review process is completed far quicker than a typical reexamination. Also, unlike a reexamination which proceeds before a patent examiner, an IPR is conducted by the Patent Trial and Appeal Board (“PTAB”) itself, which will provide valuable expertise for the proceeding. *See* 35 U.S.C. §316(c).

8. At the conclusion of the IPR, the USPTO will issue an order that either: (1) invalidates one or more claims of the '529 patent, (2) affirms the validity of one or more claims of the '529 patent,

1 or (3) amends one or more claims of the '529 patent. 35 U.S.C. § 307. If the IPR results in the
2 invalidity of all of the '529 patent claims, there will be no need to litigate this case. Also, once the
3 PTO makes a decision, all participating parties will be estopped from re-litigating the same invalidity
4 issues that were raised or reasonably could have been raised during the IPR. *See* 35 U.S.C. §
5 315(e)(2). Further, the additional prosecution history will help clarify the scope of the claims. This is
6 particularly true where, as here, a party has requested review of each of the asserted claims of the
7 patents-in-suit. *See Pragmatus AV, LLC v. Facebook, Inc.*, No. 11-CV-02168-EJD, 2011 WL 4802958,
8 at *3 (N.D. Cal. Oct. 11, 2011) (staying action pending inter partes reexamination, even before the
9 PTO determined whether reexamination was warranted, in part because defendant's request for
10 reexamination included all claims at issue in the litigation).

11 9. Conversely, if the requested stay is denied and the litigation proceeds parallel to the
12 IPR, the Court's claim construction ruling may have to be re-visited after the claims are modified. It
13 thus makes little sense to construe the terms of the '529 Patent, and then expend time, energy, and
14 resources to litigate the '529 Patent, when the IPR could undo some or all of these efforts.

15 10. Staying the litigation pending conclusion of the IPR may also prevent duplicative
16 discovery efforts. Should the asserted claims of the '529 Patent be amended during the IPR, it is
17 possible that the Parties will seek to re-depose witnesses concerning issues implicated by additional
18 prosecution history or modified claims. The Parties desire to avoid this possibility.

19 11. With respect to the third factor, all Parties are in favor of the stay. Thus, the stay will
20 cause no prejudice to any of the Parties.

21 12. Should the Court desire, the Parties will provide periodic updates regarding the status of
22 the IPR.

1 13. Subject to the Court's approval, the Parties stipulate that all deadlines in this matter will
2 be stayed until the IPR is complete. A proposed Order is submitted herewith.

3 14. For the foregoing reasons, the Parties request that the Court stay this litigation
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5 Dated: April 12, 2013

Respectfully submitted,

6 /s/ Brent N. Bumgardner
7 Brent N. Bumgardner
8 Texas State Bar No. 00795272
9 bbumgardner@nbclaw.net
10 Christie B. Lindsey
11 Texas State Bar No. 24041918
12 clindsey@nbclaw.net
13 Jonathan H. Rastegar
14 Texas State Bar No. 24064043
15 jrastegar@nbclaw.net
16 NELSON BUMGARDNER CASTO, P.C.
17 3131 West 7th Street, Suite 300
18 Fort Worth, Texas 76107
19 Telephone: (817) 377-9111
20 Facsimile: (817) 377-3485

21 **ATTORNEYS FOR PLAINTIFF**
22 **JONGERIUS PANORAMIC**
23 **TECHNOLOGIES, LLC**

24 Respectfully submitted,

25 /s/ Charanjit Brahma
26 Charanjit Brahma (Cal. Bar. No. 204771)
Kakoli Caprihan (pro hac vice)
Jack Lin (pro hac vice)
Jim W. Fang (pro hac vice)
GREENBERG TRAURIG, LLP
2101 L Street NW, Suite 1000
Washington, DC 20037
(202) 331-3100

Scott J. Bornstein (pro hac vice)
GREENBERG TRAURIG, LLP
MetLife Building

200 Park Avenue
New York, NY 10166
(212) 801-9200

Vera Ranieri (Cal. Bar No. 271594)
GREENBERG TRAURIG, LLP
4 Embarcadero Center, Suite 3000
San Francisco, CA 94111-5983
(415) 655-1300

**ATTORNEYS FOR DEFENDANT GOOGLE
INC.**

Respectfully submitted,

/s/ James R. Batchelder
JAMES R. BATCHELDER
ROPES & GRAY LLP
1900 University Ave, 6th Floor
East Palo Alto, CA 94303
Telephone: 650-617-4000
Facsimile: 650-617-4090
james.batchelder@ropesgray.com

KHUE V. HOANG
JOSEF B. SCHENKER (pro hac vice)
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036
Telephone: 212-596-9000
Facsimile: 212-596-9090
khue.hoang@ropesgray.com
josef.schenker@ropesgray.com

PAUL M. SCHOENHARD (pro hac vice)
ROPES & GRAY LLP
One Metro Center
700 12th Street, NW, Suite 900
Washington, DC 20005-3948
Telephone: 202-508-4600
Facsimile: 202-508-4650
paul.schoenhard@ropesgray.com

**ATTORNEYS FOR DEFENDANT APPLE
INC.**

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/s/ Brent N. Bumgardner
Brent N. Bumgardner

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/s/ Brent N. Bumgardner
Brent N. Bumgardner